UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,117	01/29/2002	Yutaka Iyoki	P21951	1205

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ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No.	Applicant(s)
		10/058,117	IYOKI, YUTAKA
		Examiner	Art Unit
		Chirag R. Patel	2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 January 2002</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-12</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. <u>2001-026850</u>.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Information Disclosure Statement

The information disclosure statement filed on July 01, 2003 fails to comply with

37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document;

each non-patent literature publication or that portion which caused it to be listed; and all

other information or that portion which caused it to be listed. It has been placed in the

application file, but the information referred to therein has not been considered. The

"English Language Abstract of JP Appln. No. 2001-28655" and *"English language*

Abstract of JP 2001-1001584" have not been received.

Claim Objections

Claim 9 is objected to because of the following informalities: The preamble fails

to include the statement "wherein the improvement comprises" or "comprising" or

"comprising of". Appropriate correction is required. Appropriate correction is required.

Claims 3,4,7,11 and are 12 objected to because of the following informalities:

The phrase "typed" is misspelled in the context of the interpretation of the claim

language. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 5-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1 recites the limitation "said obtained IP address" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 and 10 recites the limitation "said decided information" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 2, 3, 6, 7, 10 and 11 recites the limitation "wherein information relating to said lease period" in line 2. There is insufficient antecedent basis for this limitation in the claim. The phrase "wherein" should serve to delimit "information relating to said lease period" It is unclear of the metes and bounds of "information relating to said lease period"

Claim 5 recites the limitation "said scanning apparatus" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "said acquired IP address" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "said stored IP address" in lines 11. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 provides for the use of a user terminal apparatus for acquiring, registering and registering an IP address, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 9 provides for the use of image information transmitting method which transmit image information to a user terminal apparatus, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use,

without setting forth any steps involved in the process, results in an improper definition

of a process, i.e., results in a claim which is not a proper process claim under 35

U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and

Clinical Products, Ltd. v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumpf

et al. (US 6,223,223).

As per claim 1, Kumpf et al. discloses an image information transmitting system

comprising:

a user terminal apparatus which obtains an IP address on an IP network;

Obtaining an IP address is inherent to and a prerequisite to communicating on an

TCP/IP network. (Col 2 lines 61-65, Figure 1 item 12)

and a scanner apparatus which transmits image information to said user terminal

apparatus using said IP address, (Col 2 lines 60-61, Col 6 lines 3-5, Figure 1 item 16)

wherein said user terminal apparatus registers said obtained IP address to said scanner

apparatus (Col 3 lines 17-20, Col 4 lines 12-14) and re-registers said IP address to said

scanner apparatus when a lease period of said IP address elapses. (Col 3 lines 66-67,

Col 4 lines 1-7, Col 4 lines 29-32, Col 5 lines 57-62)

As per claims 2 and 10, Kumpf et al. discloses wherein information relating to

said lease period is decided by said user terminal apparatus, and said decided

information is sent to said scanner apparatus from said user terminal apparatus. (Col 4

lines 1-7, Col 4 lines 29-32, Col 5 lines 6-9)

As per claims 3, 7, and 11, Kumpf et al. discloses wherein information relating to

said lease period is sent to said scanner apparatus from said user terminal apparatus

using a connectionless typed communication protocol. (Col 2 lines 50-54)

As per claims 4 and 12, Kumpf et al. discloses wherein said connectionless typed

communication protocol is a UDP protocol. UDP is a connectionless typed protocol and

is inherent in the TCP/IP protocol stack. (Col 2 lines 64-65)

As per claim 5, Kumpf et al. discloses a scanner apparatus (Col 2 lines 60-61,

Col 2 lines 66-67, Col 3 lines 2-4) which transmits image information to a user terminal

apparatus (Col 6 lines 4-5) which obtains an IP address on an IP network using said IP

address comprising:

a user terminal IP address acquiring section which acquires said IP address

obtained by said user terminal apparatus based on a notification sent from said

scanning apparatus; (Col 2 lines 61-66, Col 3 lines 15-16)

an IP address storing section which stores said acquired IP address; (Col 2 line

36, Col 4 lines 12-14) and an IP address managing section which deletes said stored IP

address from said IP address storing section when a lease period of said IP address

elapses. (Col 5 lines 36-43, Figure 2B item 106, Figure 2C item 66c)

As per claim 6, Kumpf et al. discloses the apparatus according to claim 5,

wherein information relating to said lease period is sent to said scanner apparatus from

said user terminal apparatus. (Col 4 lines 1-7, Col 4 lines 29-32, Col 5 lines 6-9)

As per claim 8, Kumpf et al. discloses a user terminal apparatus (Figure 1 item

12) comprising:

an IP address acquiring section which acquires an IP address on an IP network;

Acquiring an IP address is inherent to and a prerequisite to communicating on an

TCP/IP network. (Col 2 lines 61-65)

and an IP address registering section which registers said acquired IP address to

a scanner apparatus, (Col 3 lines 7-9, Figure 2A item 18)

wherein said IP address registering section re-registers said IP address to said scanner

apparatus when a lease period of said acquired IP address elapses. (Col 3 lines 66-67,

Col 4 lines 1-7, Col 4 lines 29-32, Col 5 lines 57-62)

As per claim 9, Kumpf et al. discloses an image information transmitting method

which transmits image information to a user terminal apparatus (Col 6 lines 3-5)

which obtains an IP address on an IP network from a scanner apparatus using said IP

address, (Col 2 lines 61-65) wherein said IP address obtained by said user terminal

apparatus is registered to said scanner apparatus (Col 3 lines 17-20, Col 4 lines 12-14)

and said IP address is re-registered to said scanner apparatus when a lease period of

said IP address elapses. (Col 3 lines 66-67, Col 4 lines 1-7, Col 4 lines 29-32, Col 5

lines 57-62)

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Kumpf et al. (US 6,839,755) discloses a network pheripheral

server discovery me network clients. Davis et al. (US 6,167,462) discloses a network

scanner software that accesses and reserves a scanner over a network to remotely

scan a document. Lo et al. (US 5,911,044) discloses a network image scanning system

which transmits image information from a scanner over a network to a client computer.

Goshey et al (US 6,327,613) discloses a system for transparently sharing peripheral

devices over a network.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Chirag R. Patel whose telephone number is (571)272-

7966. The examiner can normally be reached on Monday to Friday from 7:30AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER